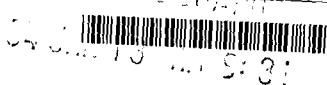


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01-07-2003
U.S. Patent & TMO/TM Mail Rpt Dt. #30

5 Attorneys for Pioneer Kabushiki
6 Kaisha dba Pioneer Corporation

8 **IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**
9 **BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

10 PIONEER KABUSHIKI KAISHA dba) **Opposition No.: 125,458**
11 PIONEER CORPORATION,)
12) Mark: SUPERSCAN ELITE
13 Opposer,) Serial No.: 76/208230
14) Published: March 19, 2002
15 vs.)
16 NISSEI SANGYO AMERICA, LTD.) **1. OPPOSITION TO APPLICANT'S**
17 Applicant.) **MOTION FOR PROTECTIVE ORDER;**
18) **2. DECLARATION OF ROBERT JAMES**
19) **SKOUSEN; and**
20) **3. CERTIFICATE OF SERVICE**
21) **DISC. CUT-OFF: March 15, 2003**

22
23
24 Assistant Commissioner For Trademarks
25 Box TTAB-No Fee
26 2900 Crystal Drive
27 Arlington, Virginia 22202-3513
28

a

1 OPPOSITION TO APPLICANT'S MOTION FOR PROTECTIVE ORDER

2 I.

3 INTRODUCTION

4 Opposer Pioneer Kabushiki Kaisha dba Pioneer Corporation
5 ("Pioneer") submits this memorandum of points and authorities in
6 opposition to Applicant Nissei Sangyo America, Ltd. now known as
7 Hitachi High Technologies America, Inc.'s ("HHTA") motion for
8 protective order with respect to the third party deposition of
9 Hitachi America, Ltd. ("HAL").

10 First, this motion is now moot because Pioneer and HAL have
11 agreed to hold the deposition in abeyance until after the January
12 14, 2003 video conference to which HHTA's motion refers. Second,
13 neither HAL nor HHTA satisfied their obligation to make a formal
14 objection to the taking of this deposition prior to the scheduled
15 and duly noticed time for the deposition. Accordingly, this
16 motion should be denied.

17 II.

18 PROCEDURAL BACKGROUND

19 On December 9, 2002, Pioneer served a subpoena *duces tecum* on
20 HAL for HAL to appear on December 20, 2002 in San Francisco,
21 California. *Skousen Decl.* ¶ 3. San Francisco is located within
22 the federal judicial district in which HAL's principal place of
23 business is located.

24 In the days that followed the service of that subpoena,
25 counsel for Pioneer and counsel for HAL spoke several times via
26 telephone regarding the possibility of either postponing the
27 deposition or of the preparation of a declaration and document
28 production in lieu of the deposition. *Skousen Decl.* ¶ 4-5.

1 Following these conversations, counsel for Pioneer provided a
2 written declaration to HAL to be signed by a person most
3 knowledgeable. Although several drafts were prepared and
4 exchanged, the last draft received by Pioneer's counsel was
5 inadequate. *Id.* at ¶ 6.

6 On December 16, 2002, Pioneer's counsel sent a letter to
7 counsel for HAL stating that if an agreement could not be reached
8 with respect to the declaration and document production, that
9 Pioneer intended to go forward with the deposition on December 20,
10 2002. *Skousen Decl. Ex. B.* Again on December 18, 2002, Pioneer's
11 counsel sent a letter to counsel for HAL and advised him that
12 because an agreement had not been reached, the deposition would be
13 going forward on December 20, 2002 in San Francisco. *Skousen*
14 *Decl. Ex. C.* A similar letter was also sent to counsel for HHTA.
15 *Skousen Decl. Ex. D.*

16 On December 19, 2002, counsel for Pioneer traveled to San
17 Francisco to take the December 20, 2002 deposition. Also on
18 December 19, 2002, Pioneer's counsel received a letter from
19 counsel for HHTA informing him that the deposition would not go
20 forward even though no formal objection to the deposition had been
21 submitted by HHTA. *Skousen Decl. Ex. E.* Pioneer's counsel
22 received a similar letter from counsel for HAL. *Skousen Decl. Ex.*
23 *F.*

24 On December 20, 2002, counsel for Pioneer appeared at the
25 deposition and took HAL's non-appearance on the record. Also on
26 December 20, 2002, HHTA filed its motion for protective order
27 prohibiting any deposition from being taken until after January
28 14, 2003. Thereafter, on December 22, 2002, Pioneer's counsel

1 sent a letter to HAL's counsel noting his client's non-appearance
2 and requesting that new dates be provided after January 14, 2003
3 in lieu of the need for requesting a contempt citation from the
4 United States District Court for the Northern District of
5 California. *Skousen Decl. Ex. G.* In response, on December 23,
6 2002, counsel for HAL sent an email to counsel for Pioneer and
7 informed him that he would provide alternative dates for the
8 deposition after January 14, 2003 by Friday, January 3, 2003.
9 *Skousen Decl Ex. H.* Thereafter, on January 2, 2003, Pioneer's
10 counsel sent a letter to counsel for HAL confirming HAL's email
11 and agreeing that the new dates would be after January 14, 2003.
12 *Skousen Decl. Ex. I.*

13 **III.**

14 **ARGUMENT**

15 **A. HHTA'S MOTION FOR PROTECTIVE ORDER IS MOOT BECAUSE OF THE**
16 **AGREEMENT BETWEEN PIONEER AND HAL NOT TO SCHEDULE THE**
17 **DEPOSITION UNTIL AFTER JANUARY 14, 2003**

18 Paragraphs five, six, eleven, and the prayer in HHTA's motion
19 for protective order make clear that the motion only requests a
20 protective order for the HAL deposition until after January 14,
21 2003. The parties agreed and confirmed that the video conference
22 would occur on January 14, 2003 for the purpose of attempting to
23 informally resolve this dispute. Although HHTA's contention that
24 there was an agreement in place to hold all discovery in abeyance
25 until after January 14, 2003 is disputed by Pioneer, HHTA's
26 contention, and this motion, have become moot because of an
27 agreement reached between Pioneer and HAL regarding a new
28 deposition date.

1 The correspondence between Pioneer and HAL on December 22 and
2 23, 2002 and of January 2, 2003 confirm that any deposition to be
3 taken with respect to HAL will not take place until after January
4 14, 2003. This motion is, therefore, moot as the deposition will
5 not be taken before that time by agreement of Pioneer and HAL.

6 Federal case law is extensive supporting a court's denial of
7 a motion for protective order because the issues in the motion
8 have become moot. A court may deny a motion to compel or a motion
9 for protective order if the issues raised in the motion are moot
10 or have otherwise been resolved. See e.g. *Season-All Industries,*
11 *Inc. v. Turkiye Sise Ve Cam Fabrikalari, A. S.*, 425 F.2d 34 (1st
12 Cir. 1970) (declaring that plaintiff's motion for protective order
13 was moot after motion for summary judgment was granted by the
14 court); *In re Aircraft Accident at Little Rock, Arkansas,*
15 *-F.Supp.2d -*, 2002 WL 31641201 (E.D.Ark. 2002) (holding that
16 motion for protective order was moot due to grant of partial
17 summary judgment); *Bell v. E. Davis Int'l., Inc.*, 197 F.Supp.2d
18 449 (W.D.N.C. 2002) (denying motion for protective order, motion
19 to compel, and motion for reconsideration all as being moot).

20 **B. NEITHER HAL NOR HHTA SERVED PROPER OBJECTIONS OR BROUGHT A**
21 **MOTION TO QUASH THE SUBPOENA PRIOR TO THE DEPOSITION DATE**

22 Federal Rule 45(c)(3)(A) states: "On timely motion, the court
23 by which a subpoena was issued shall quash or modify the subpoena
24 if it...(iv) subjects a person to undue burden." Fed. R. Civ. P.
25 45(c)(3)(A)(iv). Neither HHTA nor HAL brought such a motion.
26 Moreover, the Official Comments to Rule 45 advise that "[A] motion
27 to quash is made to the court 'by which' the subpoena was issued,
28 which means the court 'from' which it issued under the language of

1 subdivision (a)(2). That will not necessarily be the court in
2 which the action is pending." Fed. R. Civ. P. 45, Off'l Comment
3 C45-22; see e.g. *Kearney for Kearney v. Jandernoa*, 172 F.R.D. 381,
4 (N.D.Ill.1997) (motion to quash must be filed and decided in court
5 from which subpoena was issued). Moreover, a witness may not
6 disregard a subpoena he has not challenged by a motion to quash.
7 *Ghandi v. Police Dept. of City of Detroit*, 74 F.R.D. 115.
8 (E.D.Mich.1977) (holding that witness was required to appear and
9 produce documents where he failed to timely bring a motion to
10 quash the subpoena).

11 Clearly, neither HHTA nor HAL brought the proper motion to
12 quash under Rule 45. Moreover, neither HHTA nor HAL has ever
13 served a proper objection to the subpoena as required by Rule 45.
14 According to Rule 45(c)(2)(B), HHTA or HAL were required to raise
15 their written objections prior to the date set for appearance
16 pursuant to the subpoena. These objections were required to be
17 set forth separately, identifying each reason for an objection to
18 the subpoena or document production. See Fed. R. Civ. P.
19 45(c)(2)(B) and *Off'l Comment* C45-21. Although letters were sent
20 by HHTA and HAL to Pioneer, neither entity properly raised their
21 objections in conformity with Rule 45. Accordingly, this motion
22 should be denied.

23 IV.

24 CONCLUSION

25 Based upon the foregoing facts, arguments, and points of law,
26 this motion for protective order should be denied. The issues
27 presented in the motion are now moot due to the correspondence
28 between Pioneer and HAL and the resulting agreement to wait until

1 after January 14, 2003 to take this deposition. Moreover, neither
2 HHTA nor HAL has complied with the proper procedural requirements
3 by filing a motion to quash or by serving proper objections to the
4 subpoena. Accordingly, the Board is respectfully, yet earnestly,
5 urged to deny this motion.

6 DATED: January 7, 2003

7
8 By: 
9 Robert James Skousen

10 Skousen & Skousen
11 A Professional Corporation
12 12400 Wilshire Blvd., Suite 900
13 Los Angeles, CA 90025-1060
14 Telephone: (310) 277-0444
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1 DECLARATION OF ROBERT JAMES SKOUSEN IN OPPOSITION
2 TO APPLICANT'S MOTION FOR PROTECTIVE ORDER

3 I Robert James Skousen, certify as follows:

4 1. I am one of the attorneys for the Opposer, Pioneer
5 Kabushiki Kaisha dba Pioneer Corporation, in the above-captioned
6 opposition now pending before the Trademark Trial and Appeal
7 Board as Opposition Number 125,458.

8 2. I make this certification in support of Pioneer's
9 Opposition to HHTA's Motion for Protective Order.

10 3. On December 9, 2002, this office served a subpoena
11 duces tecum on Hitachi America, Ltd. ("HAL") for HAL to appear on
12 December 20, 2002 in San Francisco, California.

13 4. In the days that followed the service of that subpoena,
14 I spoke with Harry Turner, counsel for HAL, several times via
15 telephone regarding the possibility of either postponing the
16 deposition or of the preparation of a declaration and document
17 production in lieu of the deposition.

18 5. Following these conversations, I provided a written
19 declaration to Mr. Turner to be signed by a person most
20 knowledgeable at HAL.

21 6. Although several drafts were prepared and exchanged,
22 the last draft received by my office was inadequate.

23 7. On December 16, 2002, I sent a letter to Mr. Turner
24 stating that if an agreement could not be reached with respect to
25 the declaration and document production, that we intended to go
26 forward with the deposition on December 20, 2002.

27 8. Again on December 18, 2002, I sent a letter to Mr.
28 Turner and advised him that because an agreement had not been

1 reached, the deposition would be going forward on December 20,
2 2002 in San Francisco. A similar letter was also sent to counsel
3 for HHTA.

4 9. On December 19, 2002, I traveled to San Francisco in
5 preparation for the December 20, 2002 deposition.

6 10. Also on December 19, 2002, my office received a letter
7 from William McGrath, counsel for HHTA, that the deposition would
8 not go forward even though no formal objection to the deposition
9 had been submitted by him.

10 11. On December 20, 2002, I appeared at the deposition and
11 took HAL's non-appearance on the record.

12 12. On December 22, 2002, I sent a letter to Mr. Turner
13 noting his client's non-appearance and requesting that new dates
14 be provided after January 14, 2003 in lieu of the need for
15 requesting a contempt citation from the Board.

16 13. on December 23, 2002, Mr. Turner sent an email to me
17 and informed me that he would provide alternative dates for the
18 deposition after January 14, 2003 by Friday, January 3, 2003.

19 14. Thereafter, on January 2, 2003, I sent a letter to Mr.
20 Turner confirming his email and agreeing that the new dates would
21 be after January 14, 2003.

22 A. Attached hereto and incorporated herein by reference
23 are true and correct copies of the following documents submitted
24 in support of this opposition to the motion for protective order:

25 Exhibit A-"Subpoena In A Civil Case" dated December 6,
26 2002 for Hitachi America, Ltd.;

27 Exhibit B-December 16, 2002 letter from Robert Skousen
28 to Harry Turner;

1 Exhibit C-December 18, 2002 letter from Robert Skousen
2 to Harry Turner;

3 Exhibit D-December 18, 2002 letter from Robert Skousen
4 to Harry Turner;

5 Exhibit E-December 19, 2002 letter from William McGrath
6 to Robert Skousen;

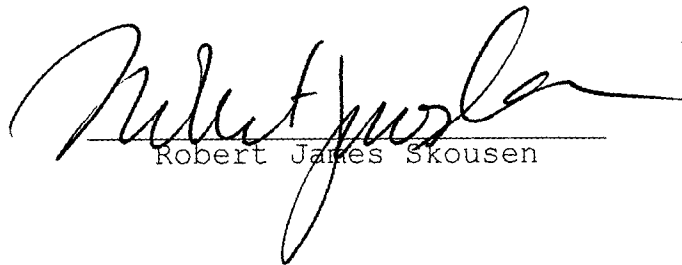
7 Exhibit F-December 19, 2002 letter from Harry Turner to
8 Robert Skousen;

9 Exhibit G-December 22, 2002 letter from Robert Skousen
10 to Harry Turner;

11 Exhibit H-December 23, 2002 electronic mail from Harry
12 Turner to Robert Skousen

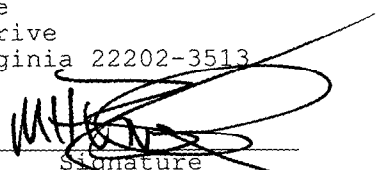
13 Exhibit I-January 2, 2003 letter from Robert Skousen to
14 Harry Turner.

15 I certify under penalty of perjury under the laws of the
16 United States of America that the foregoing is true and correct.
17 Executed this 7th day of January 2003.

18
19
20 
21 Robert James Skousen

22
23 I certify that this correspondence is being deposited
24 with the United States Postal Service with sufficient
postage as Express Mail Post Office to Addressee in an
envelope addressed to:

25 Assistant Commissioner for Trademarks
26 Box TTAB-No Fee
27 2900 Crystal Drive
28 Arlington, Virginia 22202-3513

on 1/7/03 
Date Signature
Mark H. Bush

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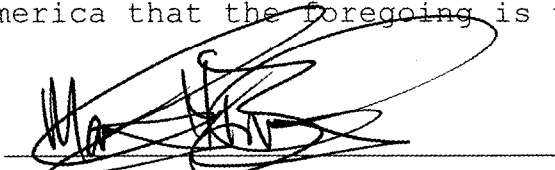
CERTIFICATE OF SERVICE

Identity of Mark: SUPERSCAN ELITE
Serial Number of Application: 76/208230
Party Filing Paper: Pioneer Corporation
Identity of Paper: Notice of Change of Address Of
Opposer's Counsel

This is to certify that on the 7th day of January 2003, a copy of the foregoing **1. OPPOSITION TO APPLICANT'S MOTION FOR PROTECTIVE ORDER; 2. DECLARATION OF ROBERT JAMES SKOUSEN; and 3. CERTIFICATE OF SERVICE** was served via First Class Mail, postage prepaid, on counsel for the Applicant at the following address:

**William T. McGrath, Esq.
Davis, Mannix & McGrath
125 South Wacker Drive, Suite 1700
Chicago, Illinois 60606-4402**

I certify under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.


Mark H. Bush